

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHUICHI NAGANO
and TAKASHI KANAI

Appeal No. 1997-4447
Application No. 08/309,907

ON BRIEF

Before THOMAS, HAIRSTON and JERRY SMITH, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

ON REQUEST FOR REHEARING

In a paper filed on July 24, 2000, bearing a certificate of mailing date of July 18, 2000, appellants request that we rehear our decision dated May 18, 2000, wherein we sustained the rejection of claims 9, 10 and 12 under 35 U.S.C. § 102.

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We have carefully reviewed our original opinion in light of appellants' request, but we find no point of law or fact which we overlooked or misapprehended in arriving at our decision even in light of appellants' current arguments set forth in the request for reconsideration. We find no error in the analysis or logic set forth in our original opinion.

In a nutshell, we basically found in our original opinion that the tracking error determinations in Koyama were a sufficient indication to the artisan of the determination of a kind of eccentricity as set forth in the preamble of the claims on appeal and in the concluding portion of the respective independent claims on appeal that we found sufficient basis to affirm the examiner's rejection of the claims on appeal. At the time of our original opinion, we were well aware that Koyama contains within its teachings distinctions between a tracking error signal and an eccentricity component determination. We, therefore, do not consider so limiting the teachings of Koyama of a tracking error signal as to exclude them from consideration of a broadly defined method of "measuring the amount of eccentricity" of an optical disk of the claims on appeal. We

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do not distinguish, as appellants apparently urge us to do, the teachings of Koyama and the subject matter of the claims on appeal on the mere basis of labels only. Our original opinion did not indicate that the tracking error signal was equivalent to the teaching in Koyama of an eccentricity component but merely that the teachings of the determination of the tracking error signal was a determination of a kind of eccentricity to the extent broadly recited in the claims on appeal.

The determination of the tracking error signal of Koyama, as we outlined in our original opinion, provides a determination of a calculated amount or extent of eccentricity to the extent recited in the claims on appeal.

The examiner clearly found the subject matter of the present claims on appeal to be unpatentable within 35 U.S.C. § 102 in contrast to those claims the examiner has allowed. Those allowed claims are 1-8, 11, 13 and 16. The examiner has thus parsed the claims to define a point of demarcation between allowable and unpatentable subject matter.

In view of the foregoing, appellants' request for reconsideration is granted to the extent that we have in fact

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reviewed our findings but is denied as to making any change
therein.

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 C.F.R.
§ 1.136(a).

JAMES D. THOMAS)
Administrative Patent Judge)
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) BOARD OF PATENT

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KENNETH W. HAIRSTON)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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APJ THOMAS

APJ HAIRSTON

APJ JERRY SMITH

RECONSIDERATION